

REMARKS

Claims 23-32 were pending in the application. Applicants have canceled claims 25-26, 28 and 30-31 without prejudice to pursuing the canceled claims in a subsequent application. Therefore, claims 23-24, 27, 29 and 32 are now pending in the application. No new matter has been added by the new claims. Support for the new claims is found throughout the specification. See, for example, the section entitled "Summary of the Invention," which describes a radially expandable tape-reinforced graft that can undergo radial enlargement without tearing or breaking; the section entitled "Radial Shrinkage of The Tape-Reinforced Graft," which describes a radially expandable tape reinforced graft comprised of a graft and a tape that have been reduced in size (e.g. radially shrunk); and page 6, which describes the formation of a longitudinally expanded graft by longitudinal expansion of a PTFE tubular extrudate, for example, by an expansion ratio of 2 to 1.

Applicants thank the Examiner for courtesies extended during a telephonic Examiner Interview on August 19, 2003, during which the above amendments were discussed. Applicants have received the Interview Summary mailed on August 25, 2003. Applicants do not completely agree with the Examiner's characterization of Applicants' view of House. The following remarks provide Applicants' record of the substance of the interview on August 19, 2003.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

The Examiner rejected claims 25-26 and 30-31 under 35 U.S.C. § 112, second paragraph. The Examiner was correct in noting that claim 25 should depend on claim 24 and not on 23. This rejection is rendered moot, though, because claim 25 has been canceled in view of the amendment of claim 23.

Applicants do not agree with the propriety of the rejections of the other claims under section 112. Claim 26 and 30-31 are product-by-process claims and, as such, are proper. See MPEP 2173.05. However, in the interest of advancing prosecution, Applicants have canceled claim 26 and 30-31, reserving the right to prosecute them in a continuation application.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

The Examiner rejected claim 23 under 35 U.S.C. § 102 as being anticipated by the admitted prior art. The Examiner's view is that claim 23 was not limited to radial enlargement of greater than 5%. Applicants have amended claim 23 to include the limitation that the radial enlargement is greater than 5%. With this added limitation, claim 23 is clearly allowable over the admitted prior art.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejected claims 24-32 as being unpatentable over the admitted prior art in view of House et al., (USPN 5026513).

Applicants respectfully disagree. House does not even remotely suggest a radially expandable tape reinforced graft that can be expanded by more than 5% without tearing of the tape. House is directed to procedures for making elastic PTFE, i.e., PTFE that would exhibit rapid recovery to its original size when it is stretched by application of tensile stress. Far from teaching it, House actually teaches away from the present invention because it teaches a form of PTFE that would return to its original size after stretching. Obviously, Applicants grafts cannot be designed to return to their original size after they are expanded because it is important for the graft to maintain its size after it is implanted.

House does not even purport to solve the problem of radially expandable grafts, i.e., the problem of tearing of the relatively thin PTFE tape used to reinforce the grafts. In fact, the words "radial" or "thin" are not even mentioned in House. What House teaches is a process for making a type of PTFE that when stretched by a force equal to 1% of the tensile strength of the PTFE will rapidly recover to its original size when the force is relieved. It is difficult to understand how this allows House to be combined with the admitted prior art to make Applicants invention obvious.

For the foregoing reasons, Applicants respectfully submit that the claims as amended are allowable over the admitted prior art in view of House et al.

DOUBLE PATENTING REJECTIONS

Applicants thank the Examiner for withdrawing the double patenting rejection as the claims being unpatentable over USPN 5,843,173. The Examiner rejected various of the claims 23-32 under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over certain claims of U.S. Patent No. 5,928,279 (the “‘279 Patent”) in view of the admitted prior art or House et al.

Applicants strongly disagree with the Examiner’s double patenting rejection. The ‘279 Patent is directed to a stented radially expandable graft. Specifically, each of the claims 1, 34 and 35 of the ‘279 Patent claims the combination of a stent with a covering. The new claims, or for that matter the pending claims, do not claim a combination that includes a stent. Thus, the invention claimed in the ‘279 Patent can be used as a stent. However, the present invention cannot be used as a stent. Thus, the two inventions are patentably distinct. Therefore, Applicants respectfully submit that the double patenting rejection over the ‘279 Patent is improper and, accordingly, should be withdrawn.

If the Examiner still deems that a double patenting rejection is proper, Applicants will submit a terminal disclaimer to expedite prosecution. In that case, the Examiner is respectfully requested to telephone the undersigned to discuss the double patenting rejection.

FEES DUE TO FILE THIS AMENDMENT

When this application was filed, a fee was paid for a total of 22 claims, with 2 of them being independent claims. The above amendment has resulted in there being a total of 5 claims, with 2 of them being independent claims. Thus, no fee is believed to be due to file this amendment.

PETITION FOR EXTENSION OF TIME TO RESPOND

Pursuant to 37 C.F.R. 1.136(a), Applicants hereby request an extension of time for **Three Months** to respond to the above-referenced Office Action. The Commissioner is hereby authorized to charge the required fee of \$930.00 to Deposit Account No. 50-1225 (VAS-4761CONDIV). A duplicate copy of this sheet is enclosed.

CONCLUSION

Accordingly, in view of the above amendments and remarks, it is submitted that this application is now ready for allowance. Early notice to this effect is solicited. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (949) 250-6801.

If an appropriate payment does not accompany or precede this submission, the Commissioner is hereby authorized to charge any required fees, such as under 37 C.F.R. §§ 1.16 or 1.17, including any petition for extension of time, or to credit any overpayment, to Deposit Account No. 50-1225.

Dated: September 2, 2003

Respectfully submitted,

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